



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,057	04/03/2002	Seiko Hirano	221519USOPCT	6859
22850	7590	04/05/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NAVARRO, ALBERT MARK	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,057

Applicant(s)

HIRANO ET AL.

Examiner

Mark Navarro

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a protein having SEQ ID NO: 2.

Group II, claim(s) 2, drawn to a protein having SEQ ID NO: 4.

Group III, claim(s) 3, drawn to a protein having SEQ ID NO: 6.

Group IV, claim(s) 4, drawn to a protein having SEQ ID NO: 8.

Group V, claim(s) 5, drawn to a protein having SEQ ID NO: 10.

Group VI, claim(s) 6, drawn to a protein having SEQ ID NO: 94.

Group VII, claim(s) 7, drawn to a protein having SEQ ID NO: 17.

Group VIII, claim(s) 7, drawn to a protein having SEQ ID NO: 18.

Group IX, claim(s) 7, drawn to a protein having SEQ ID NO: 19.

Group X, claim(s) 7, drawn to a protein having SEQ ID NO: 20.

Group XI, claim(s) 8, drawn to a protein having SEQ ID NO: 22.

Group XII, claim(s) 9, drawn to a protein having SEQ ID NO: 24.

Group XIII, claim(s) 10, drawn to a protein having SEQ ID NO: 26.

Group XIV, claim(s) 11, drawn to a protein having SEQ ID NO: 28.

Group XV, claim(s) 12, drawn to a protein having SEQ ID NO: 30.

Group XVI, claim(s) 13, drawn to a protein having SEQ ID NO: 32.

Art Unit: 1645

Group XVII, claim(s) 14, drawn to a protein having SEQ ID NO: 34.

Group XVIII, claim(s) 15, drawn to a protein having SEQ ID NO: 80.

Group XIX, claim(s) 16, drawn to a protein having SEQ ID NO: 90.

Group XX, claim(s) 17-18 and 49, drawn to a DNA which codes for SEQ ID NO: 2.

Group XXI, claim(s) 19-20 and 49, drawn to a DNA which codes for SEQ ID NO: 4.

Group XXII, claim(s) 21-22 and 49, drawn to a DNA which codes for SEQ ID NO: 6.

Group XXIII, claim(s) 23-24 and 49, drawn to a DNA which codes for SEQ ID NO: 8.

Group XXIV, claim(s) 25-26 and 49, drawn to a DNA which codes for SEQ ID NO: 10.

Group XXV, claim(s) 27-28 and 49, drawn to a DNA which codes for SEQ ID NO: 93.

Group XXVI, claim(s) 29-30 and 49, drawn to a DNA which codes for SEQ ID NO: 17.

Group XXVII, claim(s) 29-30 and 49, drawn to a DNA which codes for SEQ ID NO: 18.

Group XXVIII, claim(s) 29-30 and 49, drawn to a DNA which codes for SEQ ID NO: 19.

Group XXIX, claim(s) 29-30 and 49, drawn to a DNA which codes for SEQ ID NO: 20.

Group XXX, claim(s) 31-32 and 49, drawn to a DNA which codes for SEQ ID NO: 22.

Group XXXI, claim(s) 33-34 and 49, drawn to a DNA which codes for SEQ ID NO: 24.

Group XXXII, claim(s) 35-36 and 49, drawn to a DNA which codes for SEQ ID NO: 26.

Group XXXIII, claim(s) 37-38 and 49, drawn to a DNA which codes for SEQ ID NO: 28.

Group XXXIV, claim(s) 39-40 and 49, drawn to a DNA which codes for SEQ ID NO: 30.

Group XXXV, claim(s) 41-42 and 49, drawn to a DNA which codes for SEQ ID NO: 32.

Group XXXVI, claim(s) 43-44 and 49, drawn to a DNA which codes for SEQ ID NO: 34.

Group XXXVII, claim(s) 45-46 and 49, drawn to a DNA which codes for SEQ ID NO: 80.

Group XXXVIII, claim(s) 47-49, drawn to a DNA which codes for SEQ ID NO: 90.

Art Unit: 1645

The inventions listed as Groups I-XXXVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Inventions XX-XXXVIII, drawn to DNA, and Inventions I-XIX, drawn to polypeptides lack a special technical feature since they are products with different structure and biological properties. The protein is made of amino acids whereas the nucleic acid consists of nucleotides. Further methods known in the art used to make the polypeptide require different reagents and parameters from the methods of making the nucleic acid encoding the protein and the method of making the polypeptide does not require the nucleic acid. For instance, the protein can be made by Merrifield chemical synthesis or affinity chromatography.

Each of the recited proteins lack a special technical feature from the other proteins in view that each identified protein has a unique primary, secondary, and tertiary structure, and a correspondingly distinct activity. Likewise, each of the DNA molecules recited in Groups XX-XXXVIII has a unique sequence of nucleotides, and each encodes distinct proteins with distinct activities.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1645

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (571) 272-0861. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Navarro
Primary Examiner
April 1, 2004